



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,850	09/17/2001	Sridharan Rangarajan	2085-00100	1436

23505 7590 05/31/2005

CONLEY ROSE, P.C.

P. O. BOX 3267

HOUSTON, TX 77253-3267

EXAMINER

RUTTEN, JAMES D

ART UNIT

PAPER NUMBER

2192

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,850

Applicant(s)

RANGARAJAN ET AL.

Examiner

J. Derek Rutten

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-9,11,13-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-9,11,13-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Acknowledgement is made of Applicant's amendment dated 21 January 2005, responding to the 27 August 2004 Office action provided in the rejection of claims 1-18, wherein claims 1, 2, 7-9, and 13 have been amended, claims 3, 4, 6, 10, 12, 16, and 18 have been canceled, and no new claims have been added. Claims 1, 2, 5, 7-9, 11, 13-15, and 17 remain pending in the application and have been fully considered by the examiner.
2. Applicant has primarily argued that the claims are not anticipated by the Yinger reference because it does not disclose updating "hard-coded applications" from alternative locations. This argument is not persuasive, as will be addressed under the *Response to Arguments* section below.
3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Amendment

4. Applicant's amendment to claim 1 appears to have resulted in a formatting error that inadvertently labeled old element (d) as "a." This element has been interpreted as a typo that should instead be labeled as --(d)--. Likewise, the new limitation labeled as "b." should likely be relabeled --(e)--.

Response to Arguments

5. Applicant has not addressed all of the drawing objections. Specifically, upgrade intervals (claim 14), and download and operation of upgrade agent (claim 15) have not been shown in the drawings.

6. In response to applicant's arguments on page 12 paragraph 3 and page 14 paragraph 2 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "hard-coded applications") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Applicant argues on page 12 paragraph 4 that Yinger fails to show "monitoring file requests such that only specific files needed by the installation application or software are requested." However, review of Yinger reveals that in response to a request to run an application that does not exist on the computer, the application is downloaded and installed. The application comprises specific files that are needed by the software. Thus the argument is not convincing.

Art Unit: 2192

8. In paragraph 5 on page 13, applicant argues that the Hewitt Smith does not disclose “monitoring the frequency of request for individual files that constitute the software application.”

However, the claim language contains limitations in the alternative “and/or”, and in this case, Hewitt Smith discloses “particular files requested” as recited in the previous Office action.

9. Applicant argues on page 14 paragraph 3 that the Heath reference does not teach “provision of the four options” referring to claim 8 elements (i)-(iv). Review of the claim shows that alternative language “and/or” is used. In this case, Heath discloses deleting a file after execution terminates as explained in the previous Office action.

10. Applicant argues on page 14 paragraph 4 that Yinger and Heath do not teach “monitoring of the frequency of request for individual files that constitute the software application” as related to claim 9. Review of the claim shows that alternative language “and/or” is used. In this case, Yinger discloses monitoring of particular files requested as explained in the previous Office action.

11. In paragraph 1 of page 15, applicant argues that the Mohammed reference does not teach an upgrade agent that monitors file requests made by an older version software. However, Mohammed does teach an upgrade module, or upgrade agent, coupled with a detection module that monitors upgrade requests made by an older version software. See column 2 line 64 – column 3 line 12:

However, if the detection module 154 detects that the software OS platform is different than the current OS platform (indicating that an operating system upgrade has occurred), then an upgrade command is issued (at 108) to invoke the upgrade module 156. Examples of some software components that may be upgraded include device drivers, DLL files, installation files and other low-level software components. In the ensuing description, such software components are referred to collectively as “target components.” One or more of these target components may have to be upgraded when the operating system is upgraded to ensure that the device drivers and other software modules will work in the new operating system. It is to be understood, however, that the software upgrade process described may be applied to any number of software components that may be loaded in the system.

The detection module functions as an extension to the operating system that executes every time the operating system is loaded. The upgrade module monitors requests by the detection module and performs the upgrade. Thus, the argument is not convincing.

Drawings

12. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the features canceled from the claims.

- Upgrade intervals (claim 14)
- Download and operation of upgrade agent (claim 15)

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified

Art Unit: 2192

and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 5, 13, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art of record U.S. Patent 5,960,204 to Yinger et al. (hereinafter "Yinger") in view of U.S. Patent 5,797,022 to Shimotono et al (hereinafter "Shimotono").

As per claim 1, Yinger discloses:

A method of distributing software over a communication network (column 1 lines 49-52) *including the steps of:*

(a) making the software available on a file server attached to the network (column 1 lines 63-64: "Otherwise, if the desired application is available on a server computer...");

(b) providing and executing an installation application on a user's computer attached to the network (column 1 lines 59-60: "In response to a client computer receiving a request from a user to run an application...");

Art Unit: 2192

(c) monitoring file requests made by the installation application (column 1 lines 59-61:

“...the client computer determines whether the application exists on the client computer.”);

(d) identifying file requests which relate to files which are not present on the user's computer (column 1 lines 59-61 as cited above);

(f) downloading the identified files from the file server (column 1 lines 64-66: “the server computer automatically installs the application on the client computer”);

(g) storing the downloaded files in storage media on the user's computer (column 1 lines 65-66: “installs the application on the client computer”); *and*

(h) directing the file requests for the identified files, and any future file requests for those files, to the downloaded versions of those files (column 1 lines 65-66 as cited above describes installing, which inherently directs requests to the installed files.).

Yinger does not expressly disclose *(e) converting file requests into file download requests*. However, in an analogous environment, Shimotono teaches that a local file request can be converted to a network download request (See column 1 lines 61-64: “If the destination for the access request is a remote disk 28 in another computer system 20 connected via a network (e.g., a local area network (LAN)), **the file system 11 redirects the file system call** to sub-file system B 13.”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Shimotono's teaching of file request conversion with Yinger's file

monitoring. One of ordinary skill would have been motivated to distribute the storage of files on a network in order to reduce local storage requirements.

As per claim 5, the above rejection of claim 1 is incorporated. Yinger further discloses: *wherein the communication network is a local area network or a private wide area network* (column 4 lines 4-9).

As per claim 13, Yinger discloses:

A method of automatically upgrading software on a user's computer over a communication network (column 1 lines 49-52) *including the steps of:*

(b) ascertaining that the software on the user's computer is an older version than the upgrade software (column 2 lines 1-5: "In an alternate embodiment of the present invention, if the application to be executed exists on the client computer, the client computer determines whether the application is the most recent version of the application available on the client/server system.");

(d) identifying file requests which relate to files which have been upgraded in the upgrade software (column 2 lines 5-9: "In response to the application not being the most recent version available, a server computer automatically installs an updated application on the client computer, which then automatically executes the application after installation of the updated application.");

All further limitations have been addressed in the above rejection of claim 1.

As per claim 14, the above rejection of claim 13 is incorporated. Yinger further discloses: *wherein the step of ascertaining that the software on the user's computer is an older version than the upgrade software occurs:*

(i) each time the software on the user's computer is executed (column 8 line 60 – column 9 line 15);

As per claim 17, the above rejection of claim 13 is incorporated. All further limitations have been addressed in the above rejection of claim 5.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger and Shimotono as applied to claim 1 above, and further in view of prior art of record U.S. Patent 6,067,582 to Hewitt Smith et al. (hereinafter “Hewitt Smith”).

As per claim 2, the above rejection of claim 1 is incorporated. Further, Yinger discloses: *(i) monitoring the particular files requested by the user's computer from the server* (column 1 lines 63-66). Yinger does not expressly disclose: *(j) requiring the owner of the user's computer to make payments based the particular files requested.*

However, in an analogous environment, Hewitt Smith teaches restricting access to software to paying customers (column 3 lines 20-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hewitt Smith's

Art Unit: 2192

billing method in Yinger's software distribution system. One of ordinary skill would have been motivated to generate revenue for proprietary software.

16. Claims 7-9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger in view of Shimotono further in view of prior art of record U.S. Patent 6,006,034 to Heath et al. (hereinafter "Heath").

As per claim 7, Yinger discloses: *A method of executing computer application software on a user's computer which is connected to a communication network* (column 1 lines 49-52). Yinger does not expressly disclose: *(i) deleting one or more of the downloaded files from the user's computer*. All further limitations have been addressed in the above rejection of claim 1.

However, in an analogous environment, Heath teaches deleting a file (column 3 lines 15-20: "The catalog file can also be specified to include a procedure to delete the components following the execution of the updated application program to free up disk space on the client."). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Heath's file deletion on Yinger's downloaded files. One of ordinary skill would have been motivated to free up disk space on a client computer.

As per claim 8, the above rejection of claim 7 is incorporated. Yinger does not expressly disclose: *wherein the step of deleting one or more of the downloaded files is done: (i) as the files are closed by the software; (ii) when execution of the software terminates; (iii) after a pre-determined time or number of days has elapsed; and/or (iii) after the software has been executed a pre-determined number of times.*

However, Heath teaches deleting a file after execution terminates (column 3 lines 15-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Heath's method of deleting after execution termination on Yinger's downloaded files. One of ordinary skill would have been motivated to allow a program to execute before deleting it.

As per claims 9 and 11, the above rejection of claim 7 is incorporated. All further limitations have been addressed in the above rejections of claims 2 and 5, respectively.

17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yinger and Shimotono as applied to claim 13 above, and further in view of prior art of record U.S. Patent 6,418,555 to Mohammed (hereinafter Mohammed).

As per claim 15, the above rejection of claim 13 is incorporated. Yinger does not expressly disclose: *an upgrade agent is downloaded from the file server to the user's computer and the upgrade agent performs the function of monitoring file requests made*

by the software to identify file requests which relate to files which have been upgraded in the upgrade software.

However, in an analogous environment, Mohammed teaches the use of an upgrade module to perform upgrade operations if an upgrade is detected (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Mohammed's upgrade module to monitor upgraded file requests in Yinger's upgrade method. One of ordinary skill would have been motivated to distinguish files that need updating from files that haven't been updated in order to reduce bandwidth consumption and download time.

Conclusion

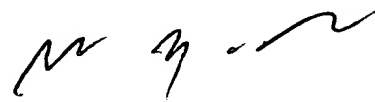
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The examiner can normally be reached on T-F 6:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2192

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr



WEI Y. ZHEN
PRIMARY EXAMINER